

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Attorney Docket No.: 38005-0164

Applicant: Volkmar WEHNER et al.

Appl. No.: 10/092,889

Examiner: S. Wright

Filing Date: March 8, 2002

Art Unit: 1626

Title: **BIS(TRIFLUOROMETHYL)HYDANTOINS AS  
INTERMEDIATES FOR PHARMACEUTICALLY ACTIVE  
INGREDIENTS**

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**APR 20 2004**

**Amendment and Reply under 37 C.F.R. § 1.116**

Commissioner for Patents  
P. O. Box 1450  
Alexandria, VA 22313-1450

Sir:

This is a Response to the Office Action mailed November 14, 2003, for the above-captioned application. Applicants request a three month extension of time to respond to the Office Action and the response therefore is due on May 14, 2004. Please charge all fees for filing this response to Deposit Account No. 08-1641.

Please amend the Application as set forth below.

**OFFICIAL**

**HellerEhrman**  
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Facsimile Transmittal

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**To:** Examiner S. Wright, US PTO  
**Telephone:**

**Fax:** 703.872.9306

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**From:** Paul M. Booth  
**Telephone:** (202) 912-2197  
**Direct Fax:**

**No. of Pages:** 12 (including cover)  
**Date:** April 20, 2004

38005.0164 (4868)

**Message:**

**Re:** U.S. Patent Application No. 10/092,889  
Filed: 8 March 2002  
For: *BIS(TRIFLUOROMETHYL)HYDANTOINS*  
*AS INTERMEDIATES FOR*  
*PHARMACEUTICALLY ACTIVE INGREDIENTS*  
Our Reference: 38005-0164

Document6  
4/20/04 6:56 PM Q

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PAGE 1/12 \* RCVD AT 4/20/2004 7:16:30 PM [Eastern Daylight Time] \* SVR:USPTO-EFAX-1/3 \* DNIS:8729306 \* CSID:202 912 2020 \* DURATION (mm-ss):03-44

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**Amendment and Reply under 37 C.F.R. § 1.116 for Serial No. 10/092,889**

This collection of information is required by 37 C.F.R. 1.8. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 C.F.R. 1.14. This collection is estimated to take 1.8 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions by reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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PTO/SB/21 (08-00)

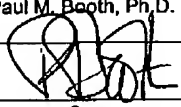
Approved for use through 10/31/2002. OMB 0651-0031

U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

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<b>TRANSMITTAL FORM</b> <i>(to be used for all correspondence after initial filing)</i>	<b>Application Number</b>	10/092,889	
	<b>Filing Date</b>	8 March 2002	
	<b>First Named Inventor</b>	Wehner et al.	
	<b>Group Art Unit</b>	1626	
	<b>Examiner Name</b>	S. Wright	
<b>Total Number of Pages In This Submission</b>	12	<b>Attorney Docket Number</b>	38005-0164

ENCLOSURES (check all that apply)		
<input checked="" type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input checked="" type="checkbox"/> Amendment / Response <input checked="" type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input checked="" type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Response to Missing Parts/Incomplete Application <input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Assignment Papers (for an Application) <input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____	<input type="checkbox"/> After Allowance Communication to Group <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input type="checkbox"/> Appeal Communication to Group (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input type="checkbox"/> Other Enclosure(s) (please identify below):
Remarks		

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT	
Firm or Individual name	Paul M. Booth, Ph.D.
Signature	
Date	April 20, 2004

CERTIFICATE OF MAILING			
I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Assistant Commissioner for Patents, Washington, D.C. 20231 on this date: <input type="text"/>			
Typed or printed name			
Signature		Date	

# FEE TRANSMITTAL for FY 2004

Effective 10/01/2003. Patent fees are subject to annual revision.

☐ Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT (\$ 950

## Complete if Known

Application Number 10/092,889  
Filing Date 8 March 2002  
First Named Inventor Wehner et al.  
Examiner Name S. Wright  
Art Unit 1626  
Attorney Docket No. 38005-0164

## METHOD OF PAYMENT (check one)

☐ Check ☐ Credit card ☐ Money Order ☐ Other ☐ None

X Deposit Account:

Deposit Account Number 08-1641 (Docket No. 38005-0164)

Deposit Account Name Heller Ehrman White & McAuliffe LLP

The Commissioner is authorized to: (check all that apply)

X Charge fee(s) indicated below X Credit any overpayments

☐ Charge any additional fee(s) during the pendency of this application

☐ Charge fee(s) indicated below, except for the filing fee to the above-identified deposit account.

## FEE CALCULATION

### 1. BASIC FILING FEE

Large Fee Code	Entity Fee (\$)	Small Fee Code	Entity Fee (\$)	Fee Description	Fee Paid
1001	770	2001	385	Utility filing fee	
1002	340	2002	170	Design filing fee	
1003	530	2003	265	Plant filing fee	
1004	770	2004	385	Reissue filing fee	
1005	160	2005	80	Provisional filing fee	

SUBTOTAL (1) (\$)

### 2. EXTRA CLAIM FEES FOR UTILITY AND REISSUE

Total Claims	Extra Claims	Fee from below	Fee Paid
20** =	x	=	
Independent Claims	3** =	x	=
Multiple Dependent		=	

Large Fee Code	Entity Fee (\$)	Small Fee Code	Entity Fee (\$)	Fee Description
1202	18	2202	9	Claims in excess of 20
1201	86	2201	43	Independent claims in excess of 3
1203	290	2203	145	Multiple dependent claim, if not paid
1204	86	2204	43	**Reissue independent claims over original patent
1205	18	2205	9	**Reissue claims in excess of 20 and over original patent

SUBTOTAL (2) (\$)

\*\*or number previously paid, if greater; For Reissues, see above

## FEE CALCULATION (continued)

### 3. ADDITIONAL FEES

Large Fee Code	Entity Fee (\$)	Small Fee Code	Entity Fee (\$)	Fee Description	Fee Paid
1051	130	2051	65	Surcharge - late filing fee or oath	
1052	50	2052	25	Surcharge - late provisional filing fee or cover sheet	
1053	130	1053	130	Non-English specification	
1812	2,520	1812	2,520	For filing a request for <i>ex parte</i> reexamination	
1804	920*	1804	920*	Requesting publication of SIR prior to Examiner action	
1805	1,840*	1805	1,840*	Requesting publication of SIR after Examiner action	
1251	110	2251	55	Extension for reply within first month	
1252	420	2252	210	Extension for reply within second month	
1253	950	2253	475	Extension for reply within third month	950
1254	1,480	2254	740	Extension for reply within fourth month	
1255	2,010	2255	1,005	Extension for reply within fifth month	
1401	330	2401	165	Notice of Appeal	
1402	330	2402	165	Filing a brief in support of an appeal	
1403	290	2403	145	Request for oral hearing	
1451	1,510	1451	1,510	Petition to institute a public use proceeding	
1452	110	2452	55	Petition to revive - unavoidable	
1453	1,330	2453	665	Petition to revive - unintentional	
1501	1,330	2501	665	Utility issue fee (or reissue)	
1502	480	2502	240	Design issue fee	
1503	640	2503	320	Plant issue fee	
1460	130	1460	130	Petitions to the Commissioner	
1807	50	1807	50	Processing fee under 37 CFR 1.17(q)	
1806	180	1806	180	Submission of Information Disclosure Stmt	
8021	40	8021	40	Recording each patent assignment per property (times number of properties)	
1809	770	2809	385	Filing a submission after final rejection (37 CFR 1.129(a))	
1810	770	2810	385	For each additional invention to be examined (37 CFR 1.129(b))	
1801	770	2801	385	Request for Continued Examination (RCE)	
1802	900	1802	900	Request for expedited examination of a design application	

Other fee (specify)

\* Reduced by Basic Filing Fee Paid

SUBTOTAL (3) (\$ 950)

## SUBMITTED BY

Name (Print/Type) Paul M. Booth, Ph.D.

Signature

Registration No. 40,244

(Attorney/Agent)

Date

April 20, 2004

## Complete (if applicable)

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